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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/414,710	10/08/1999	SCOTT FABER	9997-003	3759

7590 03/21/2003

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EXAMINER

MEINECKE DIAZ, SUSANNA M

ART UNIT	PAPER NUMBER
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3623

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DATE MAILED: 03/21/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/414,710

Applicant(s)

FABER ET AL.

Examiner

Susanna M. Diaz

Art Unit

3623

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 February 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 109-136 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 109-136 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

1. This Final Office action is responsive to Applicant's amendment filed February 3, 2003.

No claims have been amended.

Claims 109-136 are pending.

2. The previous objection to the abstract is withdrawn in response to Applicant's replacement abstract.

Terminal Disclaimer

3. The terminal disclaimer filed on February 3, 2003 disclaiming the terminal portion of any patent granted on this application which would extend beyond the expiration date of U.S. Patent No. 6,223,165 and U.S. Application Nos. 09/733,872, 09/782,925, and 09/782,984 has been reviewed and is accepted. The terminal disclaimer has been recorded.

Response to Arguments

4. Applicant's arguments filed February 3, 2003 have been fully considered but they are not persuasive.

Applicant argues the following:

The mere fact that a reference can be combined or modified does not render the resultant combination obvious unless the prior art also suggest the desirability of the modification or combination. *In re Mills*, 916 F.2d 80, 16

USPQ2d 1430 (Fed. Cir. 1990). Although a prior art device “may be capable of being modified to run the way the apparatus is claim, there must be a suggestion or motivation in the reference to do so. *In re Mills*, 916 F.2d 680, 682, 16 USPQ2d 1430, 1432 (Fed. Cir. 1990). (See also MPEP 2143.01).

The Lauffer reference has not been identified to suggest the desirability of the modification to include the claimed limitation of a controller computer using a customer’s selection of a service provider to initiate a process of establishing a telephonic connection between a service provider and a customer, wherein the process of establishing the telephonic connection includes at least subsequently prompting the customer as to whether the customer wants to establish the telephonic connection with the service provider from the list. (Page 10 of Applicant’s Response)

The Examiner respectfully disagrees with Applicant’s position. In response to Applicant’s argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves **or in the knowledge generally available to one of ordinary skill in the art**. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the motivation to combine the teachings of Lauffer with the Official Notice teaching that “it is old and well-known in the art of Internet/telephonic connections to allow a user to verify a desire to connect to or disconnect from another party” was gleaned from the knowledge generally available to one of ordinary skill in the art. More specifically, this knowledge was summarized as follows: “For example, Internet users are often provided with the

options of connecting, disconnecting, canceling a request, etc. These options are standard in the art and they allow a user to prevent or cancel undesired connections or to even abort an existing connection that is simply no longer needed (thereby conserving system resources)." Therefore, the Examiner submits that she has adequately met her burden of establishing a *prima facie* case of obviousness regarding the claimed invention. As such, the art rejection of record is maintained and reproduced below for Applicant's convenience.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 109-136 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lauffer (U.S. Patent No. 6,223,165 B1).

Lauffer discloses a method of connecting two parties in real time, the method comprising:

[Claim 109] displaying a list of service providers to a customer via an internet connection with the customer prior to the customer submitting a question (claim 1);

the list indicating individually whether each service provider in the list of service providers is currently available to telephonically communicate with the customer at a time when the customer is viewing the list (claim 1);

receiving a customer selection of a displayed icon corresponding to a service provider from the list (claim 1); and

a controller computer using the selection from the customer to initiate a process of establishing a telephonic connection between the service provider and the customer prior to the customer submitting a question to the service provider (claim 1);

the process of establishing the telephonic connection further includes the controller computer placing a telephone call to the service provider, and the controller computer placing a telephone call to customer (claim 1);

[Claim 110] after establishing the telephonic connection between the service provider and the customer, changing the indication of the current availability status for the service provider (col. 6, lines 30-33; claim 3 – The expert's, i.e., service provider's, availability status is presumably updated with every change in status);

[Claim 111] after the telephone connection has ended, prompting the customer to evaluate the service provider (claim 2);

[Claim 112] wherein the list is provided in response to a category selection (col. 5, lines 3-7; col. 9, lines 32-35);

[Claim 113] wherein the service provider and the customer each have a telephone number, and the telephonic connection is established without disclosing the telephone number of the service provider to the customer and without disclosing the telephone number of the customer to the service provider (col. 9, lines 15-21);

[Claim 114] tracking how long the telephonic connection is maintained between the service provider and the customer (claim 13); and

billing the customer based upon how long the telephonic connection is maintained (claim 14);

[Claim 115] before providing the list, setting up an account for the service provider (claim 15); and

crediting the account for an amount based upon how long the telephonic connection is maintained (claim 15);

[Claim 116] before providing the list, setting up a customer account for the customer (claim 17);

[Claim 118] tracking how long the telephonic connection is maintained between the service provider and the customer (claim 19); and

deducting from the customer account an amount based upon how long the telephonic connection is maintained (claim 19).

Regarding claim 109, Lauffer allows a customer to request a telephonic connection with an expert (claim 1), yet Lauffer does not explicitly teach, upon establishing the telephonic connection, the subsequent prompting of the customer as to whether the customer wants to establish the telephonic connection with the service provider from the list. However, Official Notice is taken that it is old and well-known in the art of Internet/telephonic connections to allow a user to verify a desire to connect to or disconnect from another party. For example, Internet users are often provided with the options of connecting, disconnecting, canceling a request, etc. These options are standard in the art and they allow a user to prevent or cancel undesired connections or

to even abort an existing connection that is simply no longer needed (thereby conserving system resources). Therefore, it would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to incorporate with Lauffer the step of subsequently prompting the customer as to whether the customer wants to establish the telephonic connection with the service provider from the list, upon establishing the telephonic connection, in order to provide a user with the convenience of preventing or canceling undesired connections or even aborting an existing connection that is simply no longer needed (thereby conserving system resources).

As per claim 117, Lauffer discloses the step of tracking how long the telephonic connection is maintained between the service provider and the customer (claim 19), yet he fails to explicitly teach the step of notifying the customer in real time of a balance in the customer account while the telephonic connection is being maintained. Lauffer does however discuss the use of credit card, cyber money, phone, or media accounts to make payment (col. 8, lines 27-29, 41). Further, Official Notice is taken that it is old and well-known in the art of service providing to refuse service to someone if that person does not have the means to pay for such a service. For example, if one's credit card is denied, service will be refused. If there is insufficient balance on a cyber money account (i.e., a prepaid user account), service is typically denied. Again, a phone call cannot be completed if the phone card used to make the call is lacking funds. Additionally, a phone call may be cut off in mid-conversation if one's funds run out. This is even analogous to the common scene in movies where the operator cuts in on an important call to announce, "Please deposit one dime." These practices protect the

respective service providers from not getting paid after providing a service.

Consequently, the Examiner asserts that it would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to interrupt a connection and request that the user of Lauffer's system add money to his/her account in response to the prepaid user account falling below a predetermined threshold (i.e., "while the telephonic connection is being maintained, notifying the customer in real time of a balance in the customer account") in order to ensure that information/service providers will adequately and timely be paid for services rendered.

[Claims 119-127] Claims 119-127 recite a computer system with limitations already addressed by the rejection of claims 109-118 above; therefore, the same rejection applies. Lauffer incorporates all of the structural elements recited in claims 119-127, including a database, server, computer, etc. (e.g., see claims 20-34 of Lauffer).

[Claims 128-136] Claims 128-136 recite an article of manufacture with limitations already addressed by the rejection of claims 109-118 above; therefore, the same rejection applies. Lauffer incorporates a computer-readable medium (e.g., see claims 35-43 of Lauffer).

Conclusion

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Susanna M. Diaz whose telephone number is (703) 305-1337. The examiner can normally be reached on Monday-Friday, 9 am - 5 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tariq Hafiz can be reached on (703) 305-9643.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Receptionist whose telephone number is (703)308-1113.

Any response to this action should be mailed to:

***Commissioner of Patents and Trademarks
Washington D.C. 20231***

or faxed to:

(703)305-7687 [Official communications; including
After Final communications labeled
"Box AF"]

Art Unit: 3623

(703)746-7048

[Informal/Draft communications, labeled
"PROPOSED" or "DRAFT"]

Hand delivered responses should be brought to Crystal Park 5, 2451 Crystal Drive, Arlington, VA, 22202, 7th floor receptionist.

Susanna M. Diaz *SMD*
Patent Examiner
• Art Unit 3623
March 19, 2003

[Signature]
TARIO R. HAFIZ
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3623